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Paper No. 9

MARK D. WIECZOREK, Ph.D., J.D.
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MAY 10 2002

ON PETITION

OFFICE OF PETITIONS

In re Application of: :
Lincoln T. Evans-Beauchamp and :
Jeremy Link :
Application No. 09/908,984 :
Filed: July 18, 2001 :
Title of Invention: DECISION ENGINE :
AND METHOD AND APPLICATIONS THEREOF :

This is in response to a Petition to prevent the inventor from obtaining access to the above-identified application file, under the Manual of Patent Examining Procedure ("MPEP") § 106, filed February 20, 2002, and supplemented via facsimile on March 28, 2002.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Petitioner avers that the present assignee is the assignee of record of the entire interest in the above-identified patent application. In support of the petition, Petitioner filed an Employee Confidentiality and Proprietary Information Agreement ("Agreement"), wherein the inventor for whom the exclusion is sought, Lincoln T. Evans-Beauchamp, agreed to assign, and thereby did assign, his entire right, title and interest, in and to each invention.

A review of Office records reveal that no assignment has been filed in the instant application.

The MPEP, § 106, provides that

[t]he assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See 37 CFR 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.

Thus, in order for an assignee to prosecute an application, the assignee must become of record pursuant to 37 CFR 3.71(c). Paragraph (c) of 37 CFR 3.71 provides that "[a]n assignee becomes of record . . . by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee."

Thirty seven CFR 3.73(b)(1) further provides that in order to request or take action in a patent or trademark matter, the assignee

must establish its ownership of the patent or trademark property . . .
.. " Petitioner may establish ownership

by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(I) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

The documentary evidence of a chain of title from the original owner to the assignee, submitted by petitioner, is insufficient to demonstrate ownership in the above-identified patent application. While the Agreement assigns inventions, it does not assign the instant application. The agreement may yet prove sufficient as an assignment of the instant application, however, ownership and transfer questions regarding patents rest, not with this Office, but with state courts. See, *Farmland Irrigation Co., Inc. v. Dopplmaier*, 48 Cal. 2d 208, 308 P.2d 732, 113 USPQ 88 (1957). See, also, *University Patents, Inc. v. Kligman*, 762 F.Supp. 1212, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991).

Petitioner must provide documentary evidence of a chain of title, in the above-identified application, from the original owner to the assignee.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



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OFFICE OF PETITIONS

In re Application of:
Lincoln T. Evans-Beauchamp and
Jeremy Link
Application No. 09/908,984
Filed: July 18, 2001
Title of Invention: DECISION ENGINE:
AND METHOD AND APPLICATIONS THEREOF:

DECISION GRANTING
STATUS
UNDER 37 CFR 1.47(a)

This is in response to a Petition Under 37 CFR 1.47(a), filed January 16, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

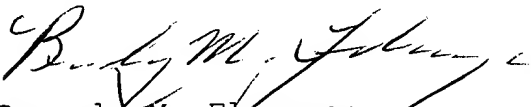
The petition is granted.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

Petitioner has shown that the non-signing inventor, Lincoln T. Evans-Beauchamp, refuses to sign the declaration after being presented with the above-identified application and declaration.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the addresses given in the Petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for continued processing.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



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In re Application of:
Lincoln T. Evans-Beauchamp and
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Application No. 09/908,984
Filed: July 18, 2001
Title of Invention: DECISION ENGINE:
AND METHOD AND APPLICATIONS THEREOF:

LETTER

OFFICE OF PETITIONS

Dear Mr. Evans-Beauchamp:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Beverly M. Flanagan
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Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy